



Paper No. 6

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In re Application of
Wright et al.
Application No. 09/782,807
Filed: February 14, 2001
Attorney Docket Number: 22-0123

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OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed February 5, 2003 under 37 CFR 1.137(a).

The petition to revive under 37 C.F.R. § 1.137(a) is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely submit a response to the Notice to File Corrected Application Papers "Notice" mailed April 6, 2001. The notice set an extendable 2 month period for reply. No extensions of time pursuant to 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on June 7, 2001. A Notice of Abandonment was mailed on January 15, 2003.

Petitioner asserts that the Notice to File Corrected Application Papers mailed on April 6, 2001 was never received. Petitioner admits there was a error in the zipcode on the patent application transmittal form. However, petitioner maintains there were several other documents with the proper zipcode in the application file. Petitioner concludes the failure to respond to the Notice was unavoidable due to failure of mail. Petitioner presents a possible chain of events which includes the U.S. Postal Service's "USPS" failure to deliver the "Notice" to the correct address notwithstanding the incorrect zipcode, the possible failure of the USPS to return the undeliverable Notice within ten business days pursuant to the envelope, and the failure of the Patent and Trademark Office to correct the correspondence address of record or contact applicants via telephone.

A review of the record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been

received and docketed must be attached to and referenced in practitioner's statement.¹ The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Notice to file Corrected Application Papers may have been lost after receipt rather than a conclusion that the Notice of Allowance was lost in the mail.

Petition to revive under 37 CFR 1.137(a)

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) the required reply,²
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 C.F.R. § 1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 C.F.R. § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).³ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the

¹M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

³See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

Petitioner's arguments have been considered but they are not persuasive. Essentially petitioner provided two different correspondence addresses with the filing of the application. Where more than one correspondence address is provided, the Office will determine which one to establish as the correspondence address. This determination is conducted on a case by case basis.⁵ The Office relies on the correspondence address that is provided with the submission of application papers⁶. Once the correspondence address becomes "of record" the address will remain the same until there is an appropriate request for a change of correspondence address made by an appropriate party.⁷ The burden is on the applicant or applicant's representative to provide the correct correspondence address. Failure to provide the appropriate correspondence address on the application transmittal form is not unavoidable. It is foreseeable if an incorrect address is provided to the Patent and Trademark Office, petitioner will likely not receive any correspondence in a timely manner.

To the extent petitioner argues the error in submitting the incorrect address occurred due to the clerical error of the patent administrator, petitioner has failed to provide the required showing to establish this was the cause in the delay.⁸

Alternative Venue

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by the required reply, the required petition fee, and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵ See MPEP 403.

⁶ See 37 CFR 1.33.

⁷ The correspondence address will also be changed prior to the filing of a 37 CFR 1.63 oath or declaration with its (the oath or declaration) filing. *Id.*

⁸ A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., *Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

There is no indication that Petitioner herein was ever empowered to prosecute the instant application. If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation and change of correspondence address must be submitted. It is noted the name of the corporation provided on the petition differs from the name of the corporation in the correspondence address of record. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

The Office acknowledges receipt of the corrected abstract submitted with the instant petition.

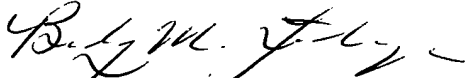
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